

REMARKS

Claims 1, 2, 5, 7, 8, 11, 13, and 14 are pending in the present application.

The rejection of Claims 1-2, 5, 7-8, 11, and 13-14 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

The Examiner's current indefiniteness rejection appears to have two aspects: (a) the use of the word "comprising" in the first line of Claims 1 and 7 appears to confuse the Examiner, and (b) the alternative definitions for various R groups has been deemed improper.

As for aspect (a) of the Examiner's indefiniteness rejection, Applicants have deleted the term "comprising" from the preamble of Claims 1 and 7 and rewritten the preamble of Claims 1 and 7 as follows:

A coated material, having a surface ~~comprising to which~~ a silane-based coating solution ~~is applied~~ to a fiber material and hardened/solidified by the action of a catalyst,  
wherein said coating solution comprises...

Therefore, Applicants submit that criticism (a) is now moot.

In regard to aspect (b) of the Examiner's indefiniteness rejection, Applicants submit that there is certainly nothing wrong with defining a single substituent as being one of a list of several things. For example, it is perfectly permissible to define substituent R<sub>9</sub> as being hydrogen, an alkyl group, or an alkenyl group. However, it appears that the Examiner's rejection relates to the recitation of "a bond of R<sub>9</sub>O and R<sub>11</sub>O to Si is an oligomer comprising a siloxane bond" in Claim 1 (similar language can be found in Claims 5, 7, 8, and 13). It appears that the Examiner considers this alternative definition for R<sub>9</sub> and R<sub>11</sub> to be unclear since it is not apparent as to the identity of these groups or whether they are even present when an oligomer is formed.

Therefore to address this ground of rejection, Applicants have amended the claims to specifically denote the meaning of the objectionable phrase. Specifically, Applicants have amended the claims so as to be consistent with the comparable language of U.S. 6,403,183 and the present specification at page 21, line 12 to page 22, line 6.

In view of the amendments herein, consistent with the Examiner's indication in the Advisory Action, Applicants request withdrawal of these grounds of rejection.

The obviousness-type double patenting rejection of Claims 1-13 over Claims 1-9 and 13-15 of US 6,403,183 in view of Marwitz et al., is obviated by submission of an executed Terminal Disclaimer.

Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), disclaiming the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of US 6,403,183. Accordingly, Applicants believe that this ground of rejection is no longer at issue and should be withdrawn.

Acknowledgement to this effect is requested.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon



Vincent K. Shier, Ph.D.  
Registration No. 50,552

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 08/03)